REMARKS

A. Status of the Claims

Claims 39-81 are pending and stand rejected, variously, under 35 U.S.C. §102, 35 U.S.C. §103 and for obviousness-type double-patenting. The specific grounds for rejection, and applicants' response thereto, are set out in detail below.

Claims 39 and 76 are amended by replacing "single coating" with "single monolayer coating." Also, claim 76 is amended to correct an obvious error ("stated" should be "state").

B. Anticipation Rejections

Claims 39-66, 68-70, 76, and 77 are rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Jiang. Applicants traverse, but in the interest of advancing the prosecution, claims 39 and 76 have been amended to recite that the "single coating" is a "single monolayer coating." On Thursday, April 29, 2010, applicants' representative discussed this amendment with Examiner Dye who indicated that the amendment would overcome the anticipation rejections. As such, applicants respectfully request entry of the amendment and withdrawal of the anticipation rejections.

C. Obviousness Rejections

1. Jiang in view of Degand, Brystche, Li or Keller

Four separate obviousness rejections are maintained against dependent claims 67, 71, 72, 73, 74, 75, 78, 79, 80, and 81. Office Action at pages 7-10. In each of these rejections, Jiang is used as the primary reference. Therefore, the arguments made in the above section concerning Jiang (lack of a teaching regarding single monolayer coating) equally apply to these obviousness

rejections and are incorporated herein by reference. Further, the secondary references used in these obviousness rejections (*i.e.*, Degand, Brytsche, Li, and Keller) do not supplement the Jiang deficiency. Therefore, because each combination of the cited art fails to disclose or suggest every element of the rejected claims, the rejection is improper. As such, applicants request that all four obviousness rejections based on Jiang as the primary reference be withdrawn.

2. Gupta in view of Jiang

Claims 39-42, 46, 48-50, 55, 57, 64-66, 68-70 and 76 stand rejected as obvious over Gupta in view of Jiang. Gupta describes a process for applying a coating on the surface of a lens, consisting of interleaving between a finished or semi-finished plastic lens preform and the surface of a mold a curable resin composition of optical quality. After curing, one obtains a cured coating bonded to the lens preform. The examiner recognizes that Gupta does not describe that the surface to which the coating is applied is a fined but unpolished surface, *i.e.*, having a roughness Rq $\geq$ 0.01 μm. However, he considers that the deficiencies of Gupta to be cured by Jiang, which is said to describe the deposition of coatings on a fined but unpolished surface. Thus, it is argued that it would have been obvious to use the optical article of Jiang having the required surface roughness in the process of Gupta because the skilled person would have been able to carry out this combination in order to achieve the predictable result of coating the surface of the optical article. Applicants traverse.

First, there is no apparent reason to combine Gupta with Jiang. Indeed, the desired result for Gupta is not a coating of the surface of an optical article, as suggested by the examiner (Office Action at page 11), and coatings are mentioned in the reference only in passing. Thus, the selection of Gupta for combination with Jiang, out of the entire lens coating literature, constitutes more than a bit of hindsight reconstruction on the part of the examiner. Moreover,

the mere fact that these references ***can*** be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art (MPEP § 2143.01[III]). Here, the examiner has failed to point out anything other than applicants' own claims to guide this combination. Such improper hindsight cannot be used to support obviousness. *In re McLaughlin* 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971). Indeed, one can argue that the combination is antagonistic given that Jiang teaches use of multiple coatings for an optical article, while Gupta suggests use of a single coating.

Second, as indicated above, Jiang points to ***an accumulation of coatings***, and not a single monolayer coating as presently claimed, to achieve a surface free of visible fining lines or corresponding to a polished state. The examiner cannot choose one characteristic of Jiang (the surface state of the article) for combination with Gupta, while turning a blind eye to other completely incompatible teachings of the reference (applying several coatings). MPEP § 2141.02, citing *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

Alternatively, one may consider the aspect of multiple coatings in Jiang as a ***teaching away*** from the present invention. A person of ordinary skill, upon reading Jiang, would be led in a direction ***divergent*** from the path that was taken by applicants to solve the technical problems underlying the invention. The person of ordinary skill in the art would have been led to transfer a stack of several coatings onto a fined but unpolished surface, leading to a high global thickness. Further, the combination of Jiang with Gupta would also lead to a process in which several coatings are applied onto the fined but unpolished surface of an optical article. Such an inconsistent teaching ***must*** be considered when considering whether to rely on this reference. *In*

re Gurley, 27 F.3d 551, 554, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994). If so considered, one could not consider applicants' solution – a single monolayer coating – obvious.

Third, applicants' claimed processes aim at obtaining an optical article free of visible fining lines (claim 39; these lines being usually suppressed by a polishing step), or having a surface state corresponding to a polished state (claim 76). Significantly, in both claims, a polished surface is excluded. There is no evidence of record suggesting that the modification of Gupta with a specifically chosen optical article of Jiang would lead to such a success, *i.e.*, could provide an unpolished optical article having a surface free of visible fining lines or a surface state corresponding to a polished state. Furthermore, the cited references fail to suggest – either individually or in combination – the possibility of obtaining the claimed invention, and it was quite unexpected that one could obtain the claimed articles by application of a single monolayer coating to a fined surface without polishing. This is yet another argument against obviousness, and in favor of patentability. MPEP § 2143.02, citing *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976); and *Amgen, Inc. v. Chugai Pharmaceutical Co.*, 927 F.2d 1200, 1207-08, 18 USPQ2d 1016, 1022-23 (Fed. Cir.), *cert. denied*, 502 U.S. 856 (1991).

It must also be pointed out that claims 61 and 62, which recite final thicknesses of 1 to 10 μm, and less than 5 μm, respectively, are separately patentable over the cited combination of Jiang and Gupta. In Jiang, the thickness of the final coating including the cured glue layer and the transferred coating is typically of 25 mm or more (see, *e.g.*, Example 9). The total thickness of the coating to be transferred is typically less than 50 μm, preferably less than 20 micrometers, or even better 10 μm or less, and the thickness of the final glue layer after curing is less than 100 μm, preferably less than 80 μm, most preferably less than 50 μm and usually 1 to 30 μm in said reference.

In sum, the rejection fails for providing an adequate motivation to combine the two references, for picking and choosing elements from the references while ignoring those aspects of the cited art that are inconsistent with the claimed invention, for overlooking a clear teaching away, and for failing to identify any basis for a reasonable prediction of success in the art. As such, applicants submit that the rejection is improper; reconsideration and withdrawal thereof is respectfully requested.

D. Double Patenting Rejection

Claims 39, 41, 42, 46, 47, 51-54, 59-62, 64, 68, 70, 76, 77, and 80 are rejected on the ground of non-statutory obviousness-type double patenting in view of claims 1-7, 10-16, and 18 Jiang. As discussed above, with respect to the obviousness rejections under §103, Jiang fails to suggested the claimed invention even when taken in combination with Degand, Brystche, Li or Keller, or alternatively, when viewed in light of Gupta. As such, those arguments apply with equal force against the claims of Jiang alone. Reconsideration and withdrawal of the rejection is therefore respectfully requested.

E. Conclusion

Applicant believes that this case is in condition for allowance and such favorable action is requested. The Examiner is invited to contact the undersigned Attorney at 512-536-3020 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,

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